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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/987,468 | 12/10/97 | GERB-BARLAG | H BEIERSDORF |

HM22/0603
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EXAMINER

LAMM, M

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

06/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/987,468

Applicant(s)
Gers-Barlag et al.

Examiner
Marina Lamm

Group Art Unit
1616



☒ Responsive to communication(s) filed on Apr 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Acknowledgment is made of the amendment filed 04/12/99. Claims pending are 12-26. Claims 1, 2 and 4-11 have been canceled.

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56.

The oath/declaration submitted by the Applicant states that the Applicant "acknowledge the duty to disclose information which is material to the **examination** of this application", which is **not** in accordance with 37 CFR 1.56.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 12-26 rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 5,876,702 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both inventions disclose sunscreen cosmetic compositions in the form of emulsions, comprising one or more organic UV filter compounds containing one or more sulphonic acid groups; one or more hydrophobic inorganic pigments incorporated into the oily phase of the emulsion; and polyglyceryl surface active compounds.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (US 5,725,844) in view of Grollier et al. (US 5,427,771).

As discussed in the previous Office Action, Gers-Barlag et al. teach a cosmetic composition in the form of O/W emulsion comprising one or more cosmetically acceptable oil- or water-soluble organic UV filter substances, including salts of 2-phenylbenzimidazole-5-sulphonic acid, sulphonic acid derivatives of benzophenones, sulphonic acid derivatives of 3-benzylidenecamphor (col. 7, lines 55-65); one or more cosmetically acceptable hydrophobic inorganic pigments, these pigments being incorporated into the oily phase of the emulsion (col. 3, lines 48-50; col. 5, lines 9-45), emulsifiers, including glyceryl stearate and glyceryl lanolate (Examples 1-4); and other cosmetically acceptable compounds. Gers-Barlag et al. also teach a method for achieving or increasing the water resistance of sunscreen formulations by incorporating the hydrophobic inorganic pigments into the oily phase of the emulsion. See col.4, lines 16-26.

Gers-Barlag et al. does not teach polyglyceryl emulsifiers as claimed in the instant claims.

However, Grollier et al. teach using mono- and diesters of fatty acids (C12-C18) and glycerol or polyglycerol (col. 5, lines 27-39) as emulsifiers in sunscreen cosmetic composition.

Both references are analogous art because they are from the same field of endeavor, which is sunscreen compositions. Polyglyceryl and monoglyceryl surface active agents are used in both references for the same art recognized purpose.

Therefore, an ordinary practitioner would have a reasonable expectation of success using either polyglyceryl or monoglyceryl emulsifiers for sunscreen cosmetic compositions in the absence

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of clear showing of any unexpected results attributable to the applicant's specific selection of polyglyceryl compounds.

Thus, the claimed invention as a whole was clearly *prima facie* obvious.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nicoll et al. (US 5,188,831) - teach sunscreen compositions containing both water-dispersible and oil-dispersible titanium dioxide together with organic sunscreens and glyceryl emulsifiers.

Robinson et al. (US 5,306,485) - teach suncare compositions containing coated titanium dioxide, organic sunscreens and emulsifiers.

Allard et al. (US 5,616,331) - teach sunscreen compositions containing coated inorganic pigments, traditional sunscreen agents, and glyceryl emulsifiers.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

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date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

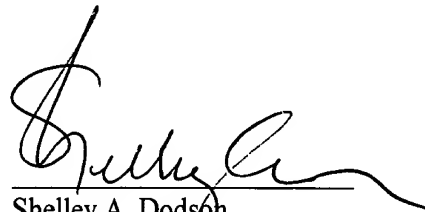
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml

May 26, 1999



Shelley A. Dodson
Primary Examiner
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